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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 34

Application Number: 08/833,342
Filing Date: 08/833,342
Appellant(s): MAA

Shalong Maa
Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 29, 2000.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief contains a statement identifying that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. There are only three issues:

a.) Whether claims 35, 37, and 43 are properly rejected under 35 U.S.C. 102(e) as being anticipated by TONG.

b.) Whether claims 36 and 38-42 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.

c.) Whether claims 44-60 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

The three issues listed above are shown on page 3 of Appellant's Appeal Brief as items (6.3), (6.4), and (6.5).

Appellant also lists on page 3 of his Appeal Brief two issues for which this Appeal Brief is not the proper avenue of redress:

"(6.1) Applying authorities such as MPEP and prior case law as basis for interpretation of statutes and as source of supporting rationale - Errors in Rejections;

(6.2) Answer all material traversed by Applicant - Errors in rejection and in rationale in support thereof;"

The issues listed by Appellant as (6.1) and (6.2) are only pertinent to this Appeal where they relate to Appellant's appeal of the rejection of claims 35-60. The specific arguments made by Appellant are discussed regarding these issues are identified specifically below in Section (11).

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with. All of claims stand or fall together since they are not independently patentable.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,636,994	TONG	6-10-1997
5,111,409	GASPER ET AL	5-5-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

a.) Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by TONG.

b.) Claims 36, 38-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.

c.) Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

The above referenced rejections are set forth in prior Office Action, Paper No. 22 and are reprinted below for convenience:

a.) Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by TONG. TONG discloses an interactive, computer-controlled doll, as described in the previous Office Action, in which actuators to move the doll's body parts. TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

TONG also discloses (in embodiment in Fig. 6) a voice-recognition feature where the user can speak into a microphone and the computer will recognize the words and provide the appropriate signal(s) to the doll. (See TONG columns 2-4 and figures 1, 6.)

b.) Claims 36 and 38-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG. TONG discloses the claimed invention except for the actuators being comprised of a "solenoid means".

However, Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

c.) Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

TONG substantially discloses the claimed invention except for specifically describing the "digital animation-control signal sequence being associated with selected audio speech ... and transmitted to the toy in synchronization with the transmission".

GASPER ET AL discloses a system for sound-synchronized animation for use in a game, as described in the previous Office Action. GASPER ET AL builds and saves its own dictionary file after determining the proper lip synchronization of an inputted word. GASPER ET AL also teaches different articulations for various sounds: silence, vowels, and consonants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

Examiner also notes that TONG does disclose the use of voice-recognition software to analyze inputted voice data. Examiner also notes that it is a standard programming technique to store inputted data of all types, including voice recognition data, in memory arrays for temporary use and in text files for permanent storage and later retrieval.

(11) Response to Arguments

In Appellant's Brief page 4, Part VIII.1, Paragraph 1A, Appellant alleges that the Examiner rejects the claims "without source of supporting rationale, such as applying case law or citation of authorities". However, the Examiner has given supporting rationale regarding the rejections in the form of explanations of how the claims in the instant application read on the prior art and how the prior art anticipates or teaches and makes obvious the claims in the instant application. Those rejections and explanations are reprinted above for convenience.

In Appellant's Brief page 4, Part VIII.1, Paragraphs 1B-1D, Appellant is apparently requesting a discussion of the legal precedents regarding the case. However, the Examiner has made the rejections based on the claims and the prior art, relying on the claimed structure and function of the invention, not on legal arguments, except where appropriate (such as where they are provided by the official Form Paragraphs.)

In Appellant's Brief pages 5-7, Part VIII.2, Paragraphs 2A1-2E2, Appellant appears to be again alleging that the Examiner gave no reason or explanation of the rejection of the claims in the instant application. Examiner maintains that this is not so and refers the Appellant again to the most recent statement of the rejections, reprinted above for convenience.

In Appellant's Brief pages 7-8, Part VIII.3, Section 8.3A (entire) and Section 8.3B, Appellant appears to be narrating his response to the Examiner's First Action on the Merits Paper No. 3), where the Examiner mistakenly referenced 102(b) instead of the correct 102(e) in the rejection of some of the claims. Examiner regrets the angst this has caused the Appellant but the mistake is irrelevant now, since the present rejection of claims 35, 37, and 43 is made clearly under 35 USC 102(e).

In Appellant's Brief pages 8-9, Part VIII.4, Sections 8.3A (entire) and Section 8.4B, paragraphs B1-B2i, Appellant argues that the elements of claims 35, 37, and 43 are not anticipated by TONG. However, TONG shows the following:

Claim 35	**Tong**
"Actuation means"	shown in TONG as motors (27, 28)
"situated within said body"	shown in TONG as (23)
"operable by an external digital animation-control signal"	in TONG the signal comes from CPU (12) and Sound Processor (18)
"said actuator having only two phases..."	in TONG the solenoid responds to the presence or absence of the signal, so there are only two phases (See TONG columns 2-4 and figures 1 and 6)
Claim 37	**Tong**
"situated within said body"	shown in TONG as (23)
"operable by an external digital animation-control signal"	in TONG the signal comes from CPU (12) and Sound Processor (18)
"and operable by the external digital animation-control signal"	in TONG the signal comes from CPU (12) and Sound Processor (18)
Claim 43	**Tong**
"said external digital control signal sequence includes a second digital control signal sequence"	TONG discloses using multiple control sequences for moving the eyes, the mouth, and doing so repetitively
"actuation means includes a first and a second actuators"	shown in TONG as motors (27, 28)
"for causing independent movements of said two movable portions"	shown in TONG as (24, 26)

In Appellant's Brief page 9, Part VIII.4, Section 8.4B, Paragraph B2-ii - Paragraph B3, Appellant appears to be restating arguments and allegations that have been addressed above.

In Appellant's Brief pages 10-11, Part VIII.5, Section 8.5A, Paragraph A1 - Paragraph A3b, Appellant states that he submitted a list of "five (5) different superior properties and functions claimed in the invention" but the Examiner "fails to state under what circumstances the presence of superior properties and new functions would be 'not sufficient to prove non-obviousness" and fails to discuss why Applicant's citation of authority does not support Applicant's traverses.

However, in the Final Rejection of the CPA (Paper No. 2), the Examiner stated:

> 21. Applicant states on page 7 sections 8.6 and 8.7 of his Response that "It is understood that presence of a superior property or property not possessed by the prior art or unexpected or greater than expected result are evidence of non-obviousness. ... In addition, absence of a property which the present invention would have been expected to possess on the teachings of the prior art also renders unobviousness [sic] of the invention. However, while this two concepts provide evidence of non-obviousness, they are not always sufficient to prove non-obviousness. More importantly, Applicant has not shown any unexpected results, superior properties, or absent properties which would obviate the rejections detailed in paragraphs 3-6 above.

The list of "five (5) different superior properties and functions claimed in the invention" given by the Appellant is little more than a restatement of the properties of the instant invention disclosed

in the Specification. The Examiner explained in the rejection of the relevant claims how the claims in the instant invention read on the prior art. Appellant's list of "five (5) different superior properties and functions claimed in the invention" have thus already been addressed. Regarding Appellants contention that the Examiner "fails to state under what circumstances the presence of superior properties and new functions would be 'not sufficient to prove non-obviousness", the Examiner suggests that Appellant is trying to place the burden of finding superior or unexpected properties of the invention with the Examiner instead of finding them himself.

In Appellant's Brief page 11, Part VIII.5, Section 8.5A, Paragraph A4a - Paragraph A4c, Appellant cites legal precedent that he alleges removes the suggestion to combine from the rejection of the claims in his own application. Examiner notes that Appellant does not specifically address which combination he is referring to, however, Examiner maintains that the suggestion to make the combination or modification for both 103(a) rejections is clear and is reprinted in section *(9)* above for convenience.

In Appellant's Brief pages 11-12, Part VIII.5, Section 8.5A, Paragraph A5a - Paragraph A5c, Appellant argues that "TONG does not teach nor suggest any digital 'animation-control' signal or any other type of control signal" and "the electronic devices employed in TONG .. do not facilitate conventional digital control of a solenoid." However, Examiner maintains that

"the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention."

In Appellant's Brief pages 12-13, Part VIII.5, Section 8.5A, Paragraph A6a - Paragraph A7c, the Appellant maintains the Examiner has "an incorrect understanding of the reference[s]". However, the Appellant does not show exactly how the Examiner's "incorrect understanding" affects the rejections of the claims and the Examiner suggests that the Appellant may have an incorrect understanding of the rejection and refers the Appellant to the rejections as reprinted above.

In Appellant's Brief page 13, Part VIII.5, Section 8.5A, Paragraph A8a - Paragraph A8b, Appellant explains he "has difficulties understanding the rationale" of the rejection of claims 36 and 38-42 under 35 U.S.C. §103(a) as being unpatentable over TONG. However, the rejection and it's explanation are clearly stated above.

Appellant further states that "it appears the Examiner also agrees Applicant's such argument of Lack of Success of Others". However, Appellant's statement is misleading. The Examiner's explanation from the previous Office Action (Paper No. 22) is reprinted here for clarification:

> 24. Applicant states on page 8 section 11.2 and 11.3 of his Response that "There is still no product in the market that is similar to the present invention ... Therefore, there is no evidence for supporting reasonable expectation of success for the proposed modification by the Examiner at the time the present invention was made, which apparently substantiate the conclusions that present invention is nonobvious."
>
> However, while success or lack thereof can be used as evidence of novelty, it is not sufficient in itself to prove novelty. More importantly, Applicant has not pointed out how success or absence in the market place obviates the rejections detailed in paragraphs 3-6 above and Examiner maintains those rejections.

In Appellant's Brief pages 13-14, Part VIII.5, Section 8.5B, Paragraph B1 - Paragraph 1B-I, Appellant states "Embodiments and/or limitations set forth in the following claim languages are not described nor suggested by TONG" and then lists the claim recitations. However, these claim limitations are effectively the same as those addressed above on pages 8-9 of this Examiner's Answer.

In Appellant's Brief pages 14-16, Part VIII.5, Section 8.5A, Paragraph 1b-ii - Paragraph 1d, Appellant lists more claims that he alleges "patentably distinguish the claimed invention from the combination of TONG and GASPER ET AL." However, the Appellant is not listing specific limitations that he believes are not taught in the combination of TONG and GASPER ET AL but rather listing all the limitations of the claims. These claim limitations are each addressed in the rejections which are reprinted in section ***(9)*** above for convenience.

In Appellant's Brief pages 16-22, Part VIII.5, Section 8.5A, Paragraph B2 - Paragraph h.3, Appellant lists his "New and different Functions and Superior Properties of the claimed invention" in theses pages. However, as Appellant states on page 17, these are simply "repeated herein as follows" and represent a restating of the aspects of the instant invention as described in the Specification and as repeatedly listed by Appellant in his remarks. These new features have been addressed fully in the rejections as repeated above and further explained in the previous responses to Appellant's arguments.

In Appellant's Brief page 22, Part VIII.5, Section 8.5A, Paragraph B3 - Paragraph 3e, Appellant argues that TONG is non-analogous art to the instant invention. Examiner disagrees and notes that TONG discloses an interactive, computer-controlled doll, as does the instant invention. Examiner suggests that when Appellant points out paragraph 3c of his Brief that "the problem with which TONG is concerned is to provide a combination of computer and an animated sounding doll and a sound signal-splitter..." the Appellant is pointing out as an inventor and as an expert in the field what the biggest challenge the inventor TONG had to overcome with his invention. However, this is reading too narrowly what TONG discloses and Examiner maintains that TONG, when read as a whole, is analogous to the art of the instant invention for the reasons stated above.

In Appellant's Brief page 23, Part VIII.5, Section 8.5A, Paragraph B4 - Paragraph 4d, Appellant argues that GASPER ET AL is non-analogous art to the instant invention. However, Examiner reminds the Appellant that GASPER ET AL discloses a system for sound-synchronized animation for use in a game, and is therefore analogous art to the instant invention.

In Appellant's Brief pages 23-25, Part VIII.5, Section 8.5A, Paragraph B5 - Paragraph 8c, Appellant argues that the combinations of prior art made in the rejections of the claims of the instant invention would not be functionally feasible but does not say why they would not be feasible, other than to allege the combination was not suggested in the art.

In Appellant's Brief page 25, Part VIII.5, Section 8.5A, Paragraph B9 - Paragraph 9b, Appellant labels the section "Lack of Success of Others" - a topic already addressed above - but actually argues that solenoids are not used for actuating body parts of dolls. While solenoids are used less now that solid state electronics are more common in toys, at the time the invention was made, solenoids were a common method of moving doll parts up or down, open or close eyes, open or close mouths, etc. The two-state operation of a solenoid made them natural choices for two-option movement: up/down, open/close, etc.

In Appellant's Brief page 26, Part IX, Appellant "respectfully points out that Applicant received the second Office Action dated 5/15/00 more than six and a half (6.5) months after Applicant's Response filed 10/27/99, and respectfully requests proper advancement of the Application proceeding". However, Appellant is reminded that when he mailed the Response on 10/27/99 (Paper No. 15), he also simultaneously filed a Petition Under 37 CFR 1.181 (Paper No. 16) which required special handling and consideration by the Group Director and also by the Office of Petitions. The Examiner submits that it is disingenuous of the Appellant to suggest that the length of time in the prosecution of this application has been caused by the USPTO. Appellant is also reminded that he has been apprised of this issue before.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner (Conferee) Jessica Harrison

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